

### REMARKS

Claims 1-19 stand rejected. No claims are added or canceled by amendment. Accordingly, claims 1-19 are at issue.

Claims 1, 3-4, 8 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over by Gaillard, U.S. Pub. No. 20030028458 in view of Stoutenberg, U.S. Pub No. 200300222135. The rejection should be withdrawn because neither reference is properly cited as prior art.

The filing date for the present application is July 10, 2000. The filing date for Stoutenberg is April 3, 2002. This is after the filing date of the present application, so Stoutenberg's filing date does not qualify the published application as prior art. Stoutenberg lists as Related U.S. Application Data that it is a continuation in part of application No. 09/634,901, filed on August 9, 2000, now U.S. Pat. No. 6,547,132. The filing date of the parent application to Stoutenberg is also after the filing date of the present application, so claiming priority from the patent application does not qualify Stoutenberg as prior art. Additionally, Stoutenberg is a mere continuation **in part** the parent patent, subject matter from Stoutenberg used in the rejection is not found in U.S. Pat. No. 6,547,132. For example, Stoutenberg comprises 29 sheets of drawings, while U.S. Pat. No. 6,547,132 has only 4. Because cited subject matter is missing from the earlier-filed application, Stoutenberg is not entitled to the filing August 9, 2000 date of the earlier-filed application:

The subject matter used in the rejection **must be disclosed in the earlier-filed application** in compliance with 35 U.S.C. 112, first paragraph, in order for that subject matter to be entitled to the earlier filing date under 35 U.S.C. 102(e).

MPEP § 706.02 (f)(1) (emphasis added). Stoutenberg also lists Provisional application No. 60/147,899, filed on August 9, 1999. However, it has not been shown that the subject matter used in the rejection is disclosed in the provisional application, and Stoutenberg is not entitled to that date, either.

The reasons why Gaillard is not prior art, as set forth in responses filed on October 27, 2005, April 27, 2005, and August 9, 2004, are incorporated herein by reference. Additionally, Gaillard is not prior art under 102(e) because the earliest application date of June 28, 2000 for a provisional application is not before the date of invention. Applicant has previously submitted a Declaration of Satyan G. Pitroda, establishing a date of invention of at least June 20, 2000. Accordingly, the rejection based on Gaillard should be withdrawn.

In summary the rejections to claims 1, 3-4, 8 and 18 should be withdrawn because the published applications were filed after the filing date of the present invention, and the subject matter of Stoutenberg relied upon in the rejections has not been shown to be entitled to the filing dates of earlier applications, because Gaillard has not been shown to be entitled to an earlier filing date, and because Gaillard's earliest possible date is after the date of invention of the present invention.

Claims 5-7 stand rejected under 35 U.S.C. § 103 over Gaillard in view of Stoutenberg and further in view of Resnick (U.S. Pub. No. 20010001321). These rejections should be withdrawn for the reasons given above, i.e., the subject matter relied upon in Stoutenberg has not been shown to be entitled to a filing date of any earlier application, and Gaillard is not properly asserted as prior art under 102(e). Additionally, the rejection of claim 7 is impermissible hindsight re-creation of the invention because there is no support given for the examiner's ipse dixit assertion that the claim would have been obvious.

Claims 9-11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Stoutenberg in view of Johnson (U.S. Patent No. 6,535,726). These rejections should be withdrawn for the reasons given above, i.e., the subject matter relied upon in Stoutenberg has not been shown to be entitled to a filing date of any earlier application. As an example, paragraphs 146-148, which comprise a portion of the subject matter relied upon for the rejection, refers to Fig. 5E. Fig. 5E is not found in the parent patent.

Claims 12-16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Despres (U.S. Patent No. 6,434,379) in view of Pitroda (U.S. Patent No. 6,769,607). Despres teaches away from the present invention because it relies on physical media. See, e.g., Col. 4, ll. 52-56 (“In order to make the radio channel operate, the customer acquires two numbers, for example concealed on a prepaid card that he purchased in any sales outlet. These two concealed numbers are an authentication key and an account number.”); Col. 4, l. 66-Col. 5, l. 5 (“Before these steps, the operator will have to put ‘scratch cards’ on sale each containing an authentication code and an account number . . . The database knows all ‘scratch cards’ that are on sale.”). The management and sale of “scratch cards,” as required by Despres, is a **problem to be solved** by the present invention:

The mobile operator incurs some **cost for producing the plastic cards, packaging and distributing them**. In addition, the mobile operator incurs costs for **tracking and managing physical inventory**, ironically for a non-physical or virtual product such as airtime.

Retailers charge the mobile operators a very high margin for the distribution of these plastic cards, as they take up expensive shelf space. These margins form one of the integral components of the overall costs incurred by the mobile operator for the distribution of plastic pre-paid cards.

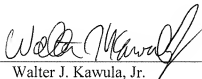
Application, p. 6 (emphasis added). However the term "virtual card" may used in Despres, that patent's concept of "virtual card" does not solve the problem of the distribution, tracking, and management of physical plastic cards. In contrast, claim 12 claims creating a virtual pre-paid card comprising a *digital* representation of information corresponding to information stored on a physical card, downloading the virtual pre-paid card to a retailer electronic transaction device, and transferring the virtual pre-paid card from the retailer electronic transaction device to a MO Subscriber Handset. Those steps are not disclosed or even suggested in Despres, because that patent relied on the physical, not digital, distribution of cards to the handset subscribers. Additionally, Despres was cited in paper no. 7, mailed February 14, 2003, with respect to claims 9-11, and then apparently withdrawn as a basis for rejection. For the foregoing reasons, claims 12-16 are allowable over Despres.

Claims 17 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Despres in view of Pitroda further in view of Tushie (U.S. Patent No. 6,202,155). The remarks concerning Despres set forth above are incorporated herein by reference. Tushie does not disclose transferring a virtual prepaid card to a retailer electronic transaction device. In contrast, Tushie appears to disclose transferring information to equipment to manufacture a "physical transaction card." Tushie, Col. 2, ll. 51-54). Because Tushie does not disclose the additional element of claim 17, claim 17 is believed allowable.

Claim 19 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over by Gaillard in view of Stoutenberg further in view of Hertzog (U.S. Pub. No. 20030069874). The reasons why Gaillard and Stoutenberg are not properly cited as prior art set forth above are incorporated herein by reference. The rejection should be withdrawn because neither reference is properly cited as prior art.

Applicant respectfully submits that the claims are in condition for allowance, and such action is earnestly submitted. If the Examiner find that there are any outstanding issues which may be resolved by a telephone interview, the Examiner is invited to contact the undersigned at the below listed number.

Respectfully submitted,  
WELSH & KATZ, LTD.

By   
Walter J. Kawula, Jr.

Registration No. 39,724

October 18, 2006

WELSH & KATZ, LTD.  
120 South Riverside Plaza, 22nd FL.  
Chicago, Illinois 60606

Phone: (312) 655-1500

Fax: (312) 655-1501